



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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in re the application of: **HAYASHI, Noriya**

Serial Number: **09/664,332**

Group Art Unit: **1712**

Filed: September 18, 2000

Examiner: **SELLERS, Robert E.**

For: **ENERGY RAY-CURING RESIN COMPOSITION**

PETITION UNDER 37 CFR §1.181 AND
SUPPLEMENTAL REPLY BRIEF UNDER 37 CFR §41.41

MAIL STOP PETITION

Commissioner of Patents
P.O. Box 1450,
Alexandria, VA 22313-1450

April 25, 2006

Sir:

In response to the Supplemental Examiner's Answer dated March 3, 2006, the following Petition under 37 CFR 1.181 and Supplemental Reply Brief under 37 CFR 41.41 is respectfully submitted. Appellant respectfully **petitions to the Commissioner** regarding the Supplemental Examiner's Answer of March 3, 2006. Appellant submits that this Supplemental Reply Brief does not include any new or non-entered amendment, or any new or non-admitted affidavit or other evidence, in accordance with 37 CFR 41.41(a)(2). Appellant believes that the present Supplemental Reply Brief does not raise new issues.

In re the application of: **HAYASHI, Noriya**
Serial No: 09/664,332
Petition and Supplemental Reply Brief

STATEMENT OF FACTS

- 1) The application was filed on September 18, 2000.
- 2) In the course of prosecution of the application, a final Office action was issued on July 7, 2005.
- 3) A Response under 37 CFR 1.116 and an Appeal Brief were filed on September 26, 2005. An advisory action was issued on October 3, 2005.
- 4) The final rejection was appealed by filing a Brief on Appeal on November 22, 2005.
- 5) An Examiner's Answer was issued on December 21, 2005.
- 6) In response, an Appellant's Reply Brief was filed on February 21, 2006.
- 7) In response to the Reply Brief, a Supplemental Examiner's Answer was issued on March 3, 2006.

POINTS TO BE REVIEWED

At issue is whether the Examiner's issuance of a Supplemental Examiner's Answer on March 3, 2006, was proper, under 37 CFR 41.43(a)(1) and MPEP 1207.05. This Petition is being submitted within the proper time for filing a Reply Brief in response to the Supplemental Examiner's Answer. This document is also labeled as a Supplemental Reply Brief to ensure that it is reviewed by the Board during the appeal.

In re the application of: **HAYASHI, Noriya**
Serial No: 09/664,332
Petition and Supplemental Reply Brief

ARGUMENTS

Appellant submits that the Supplemental Examiner's Answer mailed on March 3, 2006, is **improper**.

37 CFR 41.43(a)(1) states that the primary examiner "may furnish a supplemental examiner's answer responding to any **new issue** in the reply brief" (emphasis added). MPEP 1207.05(I) states: "The examiner **cannot** issue a supplemental examiner's answer if the reply brief raised no new issue" (emphasis added). This portion of the MPEP provides examples of "new issues."

In addition, MPEP 1207.05 states that the "examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a reply brief" (emphasis in original), consistent with 37 CFR 41.43(a)(2).

Appellant notes, first of all, that nowhere in the Supplemental Examiner's Answer does the Examiner identify any argument from the Reply Brief as being a "new issue."

Moreover, in fact, none of the 13 numbered paragraphs of the Supplemental Examiner's Answer appears even to refer to any argument from the Reply Brief. There is no reference in the Supplemental Examiner's Answer to any page number of the Reply Brief, nor any mention of anything stated by the Appellant in the Reply Brief. Specifically:

Paragraphs 1-10 of the Supplemental Examiner's Answer discuss only the cited references.

Paragraph 11 states that "burden of proof shifts to appellant", but this paragraph **does not refer specifically to any argument made at any time during prosecution**.

Paragraph 12 mentions the Declaration filed on May 13, 2004, but **does not refer to any**

In re the application of: **HAYASHI, Noriya**
Serial No: **09/664,332**
Petition and Supplemental Reply Brief

argument made more recently than that.

Paragraph 13 discusses an aspect of the claim wording, but again refers to no particular argument made during prosecution.

Finally, Paragraph 14 of the Examiner's answer states: "There is no evidence of record that the tested results are applicable ...". This remark, referring to an apparent absence of Applicant's arguments, appears to confirm that the Examiner's arguments are not in response to **any** argument made by the Appellant during prosecution.

Therefore, the Examiner's arguments in the Supplemental Examiner's Answer are not in response to any argument made by Appellant, and certainly not in response to any perceived new issue in the Reply Brief.

Appellant submits that Appellant raised no new issue in the Reply Brief of February 21, 2006. Therefore, Appellant submits that the Supplemental Examiner's Answer is **improper**. Accordingly, Appellant has filed this Petition and has not responded directly to the remarks made in the Supplemental Examiner's Answer.

RELIEF REQUESTED

Appellant therefore requests the following relief:

- 1) The Supplemental Examiner's Answer of March 3, 2006, should be indicated to be improper before forwarding the appeal to the Board of Patent Appeals and Interferences.
- 2) No further Supplemental Examiner's Answer should be issued, and the appeal should be expeditiously forwarded to the Board.

In re the application of: **HAYASHI, Noriya**
Serial No: **09/664,332**
Petition and Supplemental Reply Brief

3) The Board should be instructed that the Supplemental Examiner's Answer was improper and should not be considered in the course of the Appeal.

While it is believed that no fee is required with this Petition and Supplemental Reply Brief, the Commissioner is authorized to charge our Deposit Account No. 01-2340 for any fee which is deemed by the Patent and Trademark Office to be required to effect consideration of this statement.

Respectfully submitted,

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